

**BRIEF AND ADDENDUM FOR APPELLEE - DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE**

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UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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Appeal No. 05-1455  
Serial No. 09/589,626

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**IN RE RONALD A. SCHACHAR**

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Appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences

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### **Representative Claim 1**

1. A prosthesis that contacts the sclera of an eyeball, said prosthesis comprising a body having a first end and a second end, said body having a planform that expands said contacted sclera to increase the effective working distance of the ciliary muscle of the eyeball.

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### **STATEMENT OF RELATED CASES**

The Director is not aware of any other appeal from the Board of Patent Appeals and Interferences (“Board”) for the United States Patent and Trademark Office (“USPTO”) in connection with this application that has previously been before this or any other court. The Director is also unaware of any other case pending in this or any other court that will directly affect, or be directly affected by, this Court’s decision in the pending appeal.

**BRIEF AND ADDENDUM FOR APPELLEE - DIRECTOR OF THE  
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**I. STATEMENT OF THE ISSUE**

The claims on appeal relate to a prosthesis that is inserted into and expands the sclera of the eye to treat presbyopia (a.k.a. farsightedness). More specifically, the prosthesis of representative claim 1 has a planform body with “a first end and a second end” that expands the sclera of the eye. The primary issue on appeal is whether substantial evidence supports the Board’s finding that representative claim 1 is anticipated by Schachar’s earlier patent, which discloses a scleral expansion band comprised of a strip of material having “overlapping ends” (*i.e.*,



“ends that may slide past one another”) that, when formed into a circular band, expands the sclera.

Another way of framing the principle issue is by analogy: Does an adjustable belt having two overlapping ends cease to have those two ends once the belt is put into use. A “yes” answer supports the Appellant’s position; a “no” answer supports the Board’s decision.

## **II. STATEMENT OF THE CASE**

This appeal arose from the examination of U.S. Patent Application No. 09/589,626 (“Schachar’s application”) by Ronald A. Schachar (“Schachar”). (A18-A47<sup>1</sup>.) The Examiner rejected claims 1-7 and 12-17 of Schachar’s application as anticipated by Schachar’s earlier patent, U.S. Patent No. 5,354,331 (“Schachar’s patent”). (A2.) The Board of Patent Appeals and Interferences (“Board”) of the United States Patent and Trademark Office (“USPTO”) affirmed the Examiner’s rejection.<sup>2</sup> (A3-A6.) The Board further maintained the rejection on rehearing. (A10-A13.) Schachar now appeals the Board’s decision to this Court.

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<sup>1</sup> Citations to Appellant’s Brief will be referred to as “Br. at \_\_,” and citations to the Joint Appendix as “A\_\_”; and citations to the Addendum as “Add at \_\_\_\_”.

<sup>2</sup> The Board also reversed the Examiner’s rejection of claims 8-11 and 18-21, as obvious under 35 U.S.C. § 103(a) over Schachar’s patent; and the rejection of claims 1-21 for being directed to non-statutory subject matter under 35 U.S.C. § 101.

### III. STATEMENT OF THE FACTS

#### A. Schachar's Claimed Invention

The claims on appeal relate to a prosthesis that is inserted into the eye to treat presbyopia. (A25-A26.) "Presbyopia" (a.k.a. farsightedness) is the "inability of the eye to focus sharply on nearby objects," and is thought to result from the loss of elasticity in the eye's crystalline lens that comes with advancing age. (A110, col.2, ll.19-25.)

Representative claim 1 states:

1. A prosthesis that contacts the sclera of an eyeball, said prosthesis **comprising** a body having a **first end and a second end**, said body having a **planform that expands** said contacted sclera to increase the effective working distance of the ciliary muscle of the eyeball.

(A1 (emphasis added).) Thus, the prosthesis of representative claim 1 has a planform body with first and second ends that contacts and expands the sclera of the eye.

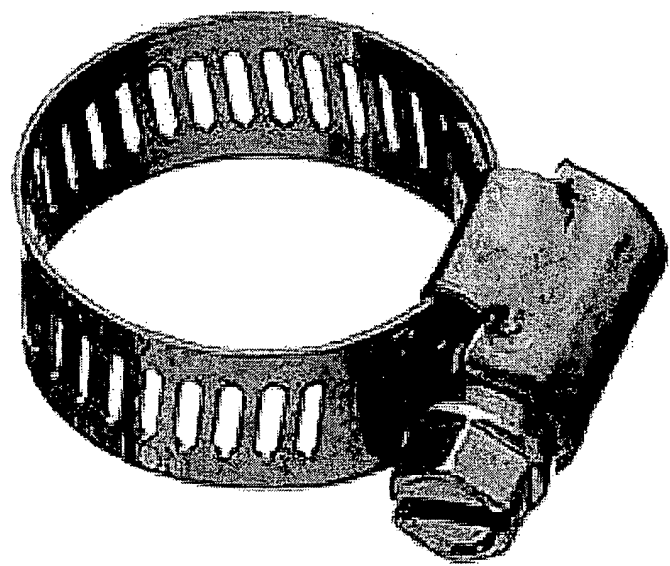
Schachar's specification discloses that the claimed prosthesis treats presbyopia by increasing the effective working range of the ciliary muscle. (*See, e.g.,* A43.) The prosthesis is inserted into an incision in the sclera, and expands the sclera by pushing upward and expanding the portion of the sclera overlying the top

of the prosthesis body. (A32, ll. 11-19; Br. at 21.) In this way, the claimed prosthesis expands the sclera and, in turn, the lens of the eye. (*Id.*)

## **B. The Prior Art: Schachar's Earlier Patent**

Representative claim 1 was rejected under 35 U.S.C. § 102(b) as anticipated by Schachar's earlier patent. Like the present application, Schachar's patent relates to a prosthesis for treating presbyopia by increasing the effective working range of the ciliary muscle. (*See, e.g.*, A105 at Abstract.) Schachar's patent teaches ring-like scleral expansion bands that may be either unitary, multi-piece, or made from a strip of material with overlapping ends formed into a ring. Each of these scleral expansion bands contacts the sclera of the eye. More specifically, Schachar's patent includes figures of several embodiments of a scleral expansion band having a unitary, frustoconical structure. (A105-A106.) In addition, at the beginning of column 7, Schachar's patent also teaches two other embodiments: (*i*) a scleral expansion band that may be made from "a plurality of parts" assembled together; and (*ii*) a band made from "a strip of material . . . with overlapping ends," akin to a belt. (A113, col.7, ll.1-12.) The latter of these embodiments is the focus of the Board's decision. Specifically, Schachar's patent states:

The band may be adjustable in circumference. For example the band may be formed from **a strip of material**, *e.g.*, metal or synthetic resin, **with overlapping ends** so that the ends may slide past one another thereby adjusting the circumference of the band. The length of the



overlap may be adjusted, for example, by means of a tangential screw mechanism to adjust the circumference of the band and thereby the amount by which the **sclera is expanded**.

(A113, col.7, ll.1-12 (emphasis added).) Thus, Schachar teaches a scleral expansion band composed of a strip of material with first and second ends that overlap, and may be adjusted by tangential screw mechanism, much like a hose clamp (*see facing page*) or a pants belt. (*See Add. at 1.*) Using this device, it is “possible to expand the sclera in the region of the ciliary body by positioning [such] a band within or just inside the sclera.” (A113, col. 7, ll. 36-38.)

### **C. The Board’s Decisions**

The Board recognized that anticipation is a two step process: (i) the claims must be construed; and (ii) all of the elements of the claims must be disclosed in a single prior art reference. As to claim construction, the Board found that Schachar’s claims were “extremely broad,” requiring only a body with a first end and a second end. (A5; *see also* A12.)

The Board found that the embodiment taught by Schachar’s patent at column 7 meets the broad scope of representative claim 1. More specifically, the Board found that column 7 of Schachar’s patent expressly teaches that its scleral expansion band may be made from “a strip of material . . . with overlapping ends so that the ends may slide past one another thereby adjusting the circumference of the

band.” (A7 (citing A113, col.7, ll.1-12); *see also* A12.) The Board agreed with the Examiner that “Schachar’s unillustrated scleral expansion band formed from a strip of material having adjustable overlapping ends responds to all of the limitations of claim 1.” (A4.)

The Board rejected Schachar’s counter-argument that his earlier patent cannot anticipate claim 1 because its unillustrated embodiments lack first and second ends. More specifically, the Board rejected Schachar’s argument that claim 1 requires the first and second ends of the claimed prosthesis to be free/unattached, and that Schachar’s patented prosthesis lacks first and second ends because the ends of the strip of material used to form Schachar’s patented scleral expansion band would “cease to exist” once the ends are attached and fastened together into the scleral expansion band. (A5.) The Board found that, given its broadest reasonable interpretation, claim 1 “neither requires the first and second ends to be free and/or unattached nor excludes these ends from being fastened or attached.” (*Id.*) The Board further found that Schachar’s arguments to the contrary were “an improper attempt to read limitations from the specification into the claim.”

(A5.) Thus, the Board sustained the rejection of representative claim 1 as anticipated by Schachar's earlier patent.<sup>3</sup> (A5-A6.)

On rehearing, the Board reiterated that representative claim 1 has a "broad scope," and again rejected Schachar's arguments regarding the first and second ends of the material strip, finding instead that Schachar's patented adjustable prosthesis clearly comprises "a body in the form of a strip of material having first and second ends," and that "[t]hese ends do not cease to exist even when the strip assumes its operative configuration." (A12.)

#### IV. SUMMARY OF THE ARGUMENT

Substantial evidence supports the Board's finding that Schachar's eye prosthesis is anticipated by his earlier patent. As the Board properly found, under the broadest reasonable interpretation, representative claim 1 is "extremely broad," simply requiring a body with a first end and a second end that expands the sclera. The Board found that Schachar's earlier patent (at column 7) satisfies all of the limitations of claim 1 by disclosing a band with "overlapping ends" that may "slide past one another" as one adjusts the band.

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<sup>3</sup> Because Schachar did not argue the separate patentability of claims 2-7 and 12-17, the Board properly found that these claims fall with representative claim 1. (A5; *see also* 37 C.F.R. § 41.37(c)(1)(vii); *In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002), and *In re Young*, 927 F.2d 588, 590 (Fed. Cir. 1991)).

Schachar's principle rebuttal argument is that once his patented band – which has two ends – is adjusted to form a circular band, the band's ends cease to exist. Schachar's argument fails for the same reason that the two ends of an adjustable belt do not cease to exist while its wearer uses the belt to hold up a pair of pants.

## **V. ARGUMENT**

### **A. Standard Of Review**

Schachar has the burden of showing that the Board committed reversible error. *In re Caveney*, 761 F.2d 671, 674 (Fed. Cir. 1985). Claim construction is a question of law that this Court reviews *de novo*. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (*en banc*). Under this standard, the Court reviews the Board's interpretation of disputed claim language to determine whether it is "reasonable." *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997).

Anticipation is a question of fact, and this Court upholds the decisions of the Board on factual matters if there is substantial evidence in the record to support the Board's findings. *In re Hyatt*, 211 F.3d 1367, 1371-72 (Fed. Cir. 2000). This Court reviews the Board's underlying factual findings for substantial evidence, and legal conclusions without deference. *Id.* Under this standard, the Board's factual determinations must be upheld unless they are not supported by substantial evidence. *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). This Court has



defined substantial evidence as that which “a reasonable mind might accept as adequate to support a conclusion.” *Id.* at 1312 (quoting *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229-230 (1938)). “[W]here two different inconsistent conclusions may reasonably be drawn from the evidence in record, an agency’s decision to favor one conclusion over the other is the epitome of a decision that must be sustained upon review for substantial evidence.” *In re Jolley*, 308 F.3d 1317, 1329 (Fed. Cir. 2002).

**B. Schachar’s Earlier Prosthesis Anticipates The Claimed Prosthesis**

The anticipation analysis is a two-step process. First, the claims must be properly construed. *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571, 1577 (Fed. Cir. 1995). Second, all of the elements of the claims must be disclosed, either explicitly or inherently, in a single prior art reference. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

There are two limitations recited in representative claim 1 that are material to this appeal: (i) the presence of a body having a first end and a second end, and (ii) the ability of that body to contact and expand the sclera. These limitations will be discussed, in turn, *infra*.

**1. Schachar's Patent Discloses A Body With A First End And A Second End As Required By Representative Claim 1**

**a. The Claimed Prosthesis Is "Extremely Broad," And Merely Requires A Body With "A First End And A Second End"**

It is well-settled that during *ex parte* prosecution the USPTO is required to give claims "their broadest reasonable interpretation consistent with the specification." *Hyatt*, 211 F.3d at 1372; *Morris*, 127 F.3d at 1054; *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995). Moreover, "[a]bsent claim language carrying a narrow meaning, the PTO should only limit the claim based on the specification or prosecution history when those sources expressly disclaim the broader definition." *In re Bigio*, 381 F.3d 1320, 1325-26 (Fed. Cir. 2004) (rejecting appellant's arguments that the term "hair brush" should be limited to only hairbrushes for the scalp where there was no express disavowal of other types of hairbrushes in the specification); *In re Amer. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1365 (Fed. Cir. 2004) (rejecting appellant's arguments that the claim term "user computer" should be limited to only "single-user computers" where no express disavowal of "multi-user computers"); *see also In re Thrift*, 298 F.3d 1357, 1364 (Fed. Cir. 2002) (rejecting appellant's arguments that the term "speech user agent" should be interpreted more narrowly where the term was used in the claim without any modifiers and no express disavowal in specification).

Representative claim 1 is directed to a prosthesis that has a planform body with first and second ends that contacts and expands the sclera of the eye:

1. A prosthesis that contacts the sclera of an eyeball, said prosthesis comprising **a body having a first end and a second end**, said body having a planform that expands said contacted sclera to increase the effective working distance of the ciliary muscle of the eyeball.

(A1 (emphasis added).) The plain language of representative claim 1 simply requires the body to have a first and second end. (*See* A12.) Accordingly, the Board found that Schachar's claims were "extremely broad," requiring only a body with a first and a second end. (A5; *see also* A12 ("the broad scope of claim 1 . . . simply calls for the recited prosthesis to comprise 'a body having a first end and a second end.'")) The plain language of representative claim 1 also does not does not state whether the first and second ends are to be either free or attached. (*Id.*) Thus, the Board reasonably found that the first and second ends of the claimed prosthesis' body may be either free or attached. (A5.)

**b. Schachar's Earlier Patent, Which Discloses A Material Strip With "Overlapping Ends" That Slide Past One Another When Adjusted, Discloses A Body With A First End And A Second End As Now Claimed**

At column 7, Schachar's patent teaches that its scleral expansion band may be made from "a strip of material, *e.g.*, metal or synthetic resin, with overlapping ends so that the ends may slide past one another":

The band may be adjustable in circumference. For example the band may be formed from a strip of material, *e.g.*, metal or synthetic resin, with **overlapping ends** so that the **ends may slide past one another** thereby adjusting the circumference of the band. The length of the overlap may be adjusted, for example, by means of a tangential screw mechanism to adjust the circumference of the band and thereby the amount by which the sclera is expanded.

(A113, col.7, ll.1-12 (emphasis added).) The Board correctly found that the overlapping ends of Schachar's patented band fully satisfy the first and second end limitation of representative claim 1.

**c. Schachar's Argument That His Patented Band Lacks First And Second Ends Is Inconsistent With The Express Teaching In Schachar's Patent At Column 7**

When the USPTO shows a prior art invention to be identical or substantially identical to the claimed invention, the burden shifts to the applicant to show novelty. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Schachar fails to present any evidence demonstrating reversible error in the Board's decision.

Schachar's argues (A63, A100; Br. at 18) that there is no anticipation because the first and second ends of the material strips used in his patented prosthesis are attached (*i.e.*, to one another), whereas the first and second ends of the claimed prosthesis are free and unattached. (A5, A12.) The Board found that "[t]hese arguments fail due to the broad scope of claim 1." (A12.) During prosecution the USPTO is required to give claims their broadest reasonable meaning in light of the specification. *Hyatt*, 211 F.3d at 1372; *Morris*, 127 F.3d at 1054. "Construing claims broadly during prosecution is not unfair to the applicant . . . because the applicant has the opportunity to amend the claims to obtain more precise claim coverage." *Amer. Acad.*, 367 F.3d at 1364. As previously discussed *supra*, the Board properly construed the first and second ends of the claimed prosthesis' body to be either free or attached. (A5.)

Moreover, Schachar was aware of and had the responsibility to remove any ambiguity in claim term meaning by amending his claims. *Bigio*, 381 F.3d at 1324 ("a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application."). Schachar made the same argument that his prosthesis' first and second ends must be free before the Examiner (A212), but never amended his claims to recite that the first and second ends were free and/or unattached. Thus, the Board found Schachar's argument to

the contrary to be “an improper attempt to read limitations from the specification into the claim.” (A5.)

Also unavailing is Schachar’s argument that there is no anticipation because the first and second ends of the material strip used in his patented prosthesis would “cease to exist” when joined together to form a prosthetic ring. (*See, e.g.*, A65, A100; Br. at 16.) As previously discussed, the Examiner recognized that the strip of material used in Schachar’s patented prosthesis is a “body comprising first and second ends, [and] a planform that expands the contacted sclera . . . .” (A77.) The Examiner noted that, even when joined together in a ring, the first and second ends still exist because “the overlapping ends play a role in facilitating circumferential adjustments of the (previously formed) scleral expansion band.” (A76-A77.) Likewise, the Board expressly found that “Schachar’s [patented] adjustable prosthesis clearly comprises such a body [having a first end and a second end] in the form of the strip of material having first and second ends,” and that “[t]hese ends do not cease to exist even when the strip assumes its operative configuration.” (A13.)

## **2. Schachar’s Patented Prosthesis Expands The Sclera**

The Board found that Schachar’s patent teaches that its band with overlapping ends will “expand the sclera in the region of the ciliary body by

positioning a band within or just inside the sclera.” (A4, A11; *see also* A113, col.7, ll.36-38.) As recognized by the Examiner, when formed into a ring, the strip of material forming the band is “a planform defining contact surfaces and at least one diameter so as to expand the sclera to increase the effective working distance of the ciliary muscles of the eyeball.” (A51.) Accordingly, the Board agreed with the Examiner that Schachar’s “scleral expansion band formed from a strip of material having adjustable overlapping ends responds to all of the limitations of claim 1.” (A5.)

Moreover, the Board properly rejected Schachar’s argument that Schachar’s patented prosthesis cannot anticipate the claimed prosthesis because it requires sutures to expand the sclera. (A64; Br. at 14-15; 20-21.) Representative claim 1 uses the open transitional term “comprising” and, therefore, does not exclude additional, unrecited elements like sutures. *See, e.g., Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.”). Moreover, Schachar’s present specification expressly states that the claimed prosthesis may be used in conjunction with hooks, fasteners, clips, sutures, glue,

etc. (A36.) Thus, the presence of sutures in the prior art prosthesis does not defeat anticipation.

Schachar also now erroneously attempts to distinguish the claimed prosthesis by arguing that it expands the sclera by “lift[ing] and pull[ing] up” the sclera itself, whereas Schachar’s patented prosthesis acts by “lifting and pulling by sutures or equivalent means.” (Br. at 10-11, 21.) This argument was never made before the Board. *See, e.g., In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004) (declining to consider new arguments regarding the scope of the prior art not contested before the Board); *Schreiber*, 128 F.3d at 1479 (declining to consider arguments not raised to the Board). Moreover, Schachar cannot distinguish his invention based on unrecited limitations. *See, e.g., MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362 (Fed. Cir. 1999). *Biophile* involved a validity challenge to a patent claim that was directed generally to a method of laser hair removal based upon a prior art disclosure of laser hair removal in guinea pigs. This Court rejected several arguments by the patentee that the prior art reference could not be used in an anticipation analysis because the reference concerned guinea pigs rather than humans. *Biophile*, 192 F.3d at 1366. Instead, this Court held that the difference between the patentee’s claim and the prior art reference were “irrelevant to the anticipation analysis” because “[n]othing in the claim limit[ed] the method’s reach



to human skin.” *Id.* If Schachar had wanted to distinguish his invention based on its mechanism of action, then he could have amended his claims to recite, for example, that “said body having a planform that expands said contacted sclera by pushing upward on the contacted sclera.” Schachar did not do so. Accordingly, this argument fails.

**3. Schachar’s Reliance On An Embodiment In His Patent Not Relied On By The Board Is Both Misleading And Irrelevant**

Schachar’s brief spends much time talking about an embodiment in Schachar’s patent that was not relied on by the Board in rejecting representative claim 1. More specifically, Schachar erroneously argues that representative claim 1 cannot be anticipated by his patented device because several material strips must be joined together for the device to function as claimed. (Br. at 7, 13, 16.) In support of this argument, Schachar’s brief includes statements by the Examiner regarding an alternative theory of anticipation not relied on by the Board. (Br. at 17.)

Schachar’s brief also includes a drawing taken from one of Schachar’s patents that is not in dispute (or of record) in this case, Figure 6 of U.S. Patent No. 6,579,316,

to show a scleral expansion band comprising multiple strips of material joined into a larger ring. (Br. at 7; *see also* A189.)<sup>4</sup>

In contrast, column 7 of Schachar's patent teaches two unillustrated embodiments: (i) a band formed from several connected pieces/arcs, and (ii) an adjustable band with overlapping ends, akin to a hose clamp or belt. (A113, at col.7, ll.1-12.) The Board relied on the second embodiment (*i.e.*, the embodiment resembling a hose clamp or belt), not the first. (A5, A11.) Specifically, in its initial decision, the Board found that Schachar's patented expansion band "formed from a strip of material having adjustable overlapping ends responds to all of the limitations of claim 1." (A4 (emphasis added).) The Board reiterated this finding on rehearing: "Schachar's adjustable prosthesis clearly comprises such a body in the form of the strip of material having first and second ends." (A12 (emphasis

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<sup>4</sup> Although not of record in this case or considered by the Board, no objection was made to the inclusion of this document in Schachar's brief because it is an accurate version of a public document.

added).) Thus, Schachar's attempt to distract the Court's attention by relying on the other embodiment is inappropriate.<sup>5</sup>

Further, this Court must reject Schachar's argument that representative claim 1 should be allowed because the USPTO has issued similar claims to him in another patent. (Br. at 19-20.) "It is well-settled that the prosecution of one patent application does not affect the prosecution of an unrelated application." *In re McDaniel*, 293 F.3d 1379, 1387 (Fed. Cir. 2002) (citing *In re Wertheim*, 541 F.2d 257, 264 (C.C.P.A. 1976) ("holding that '[i]t is immaterial in *ex parte* prosecution whether the same or similar claims have been allowed'")); *see also In re Nett Designs*, 236 F.3d 1339, 1342 (Fed. Cir. 2001) ("The Board must decide each case on its own merits [and] the PTO's allowance of such prior registrations does not bind the Board or this court"); *In re Gyurik*, 596 F.2d 1012, 1018 n.15 (C.C.P.A.

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<sup>5</sup> Moreover, broad representative claim 1 might still be anticipated by Schachar's teaching that the prosthesis may be made from a plurality of separate pieces. It is well-settled that claims using the transitional term "comprising" are open-ended and may include additional, unrecited elements. *See, e.g., Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) ("'Comprising' is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim."); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686 (C.C.P.A. 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948); *see also* Manual of Patent Examining Procedure ("MPEP"), § 2111.03 (8th ed. 2004). The open transitional phrase "comprising" in representative claim 1 does not exclude additional, unrecited elements, such as

1979) (“this court does not consider allowed claims in other applications or patents”).

Finally, looking at Schachar’s current preferred embodiment, it is possible that Schachar has discovered something new. However, his current claims do not distinguish his earlier teachings. As found by the Board, Schachar’s claims are “extremely broad.” (A5, *see also* A12.) Narrowing his claims by amendment might have distinguished his prior art patent. For example, Schachar could have amended his claims to recite that the first and second ends are free or unattached; that the first and second ends be at opposite ends of the prosthesis body, or that the prosthesis body pushes upward on the sclera to expand the sclera. Amendments like these might have distinguished his current claims over his earlier teachings. However, given the current, broadly written claims, the Board was correct in rejecting representative claim 1.

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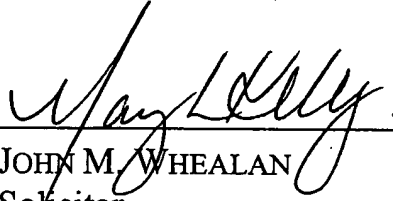
other material strips. *Id.* However, this issue is not before this Court because the Board did not rely on this embodiment to reject claim 1.

## VI. CONCLUSION

Because substantial evidence supports the Board's factfinding and legal conclusion that Schachar's claims are anticipated by his earlier patent, the Board's decision should be affirmed.

Respectfully submitted,

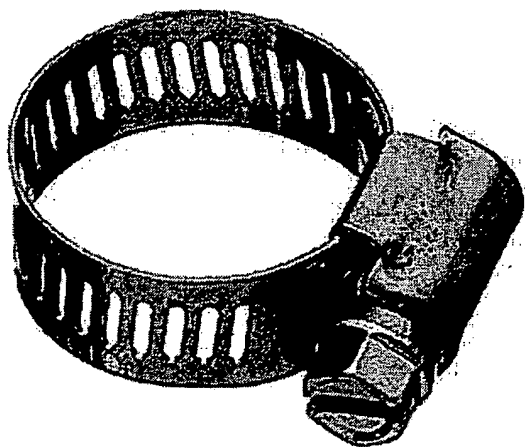
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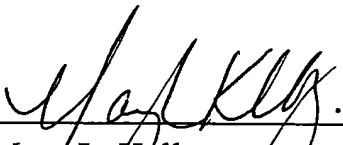
# **ADDENDUM**



**CERTIFICATE OF SERVICE**

I certify that on January 23, 2006, I caused two copies of the foregoing BRIEF AND ADDENDUM FOR APPELLEE - DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE to be mailed by United States mail (first-class, postage prepaid), addressed as follows:

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